



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,158	01/19/2006	Makoto Akihata	283583US6PCT	7307
22850	7590	04/15/2011		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER KANAAN, SIMON P				
ART UNIT		PAPER NUMBER		
2432				
NOTIFICATION DATE		DELIVERY MODE		
04/15/2011		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

# Office Action Summary

**Application No.**

10/565,158

**Applicant(s)**

AKIHATA, MAKOTO

**Examiner**

SIMON KANAAN

**Art Unit**

2432

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 February 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/11/2011 has been entered.
2. Applicant's arguments/ amendments with respect to pending claims 1 through 14 filed 2/11/2011, have been fully considered but are not persuasive.

**Applicant's arguments:**

3. Applicant's arguments that the cited prior art does not disclose "reproduction means for checking whether said authentication result information indicates that said content reproduction apparatus or said user has been registered..., and, when said authentication result information indicates that said content data reproduction apparatus or said user has not been registered, checking said attribute information of said plurality of content data items".
4. Stefik does not teach "transmission means"

**Response to applicant's arguments:**

5. Applicant's arguments/ amendments with respect to pending claims 1 through 14 filed 2/11/2011, have been fully considered and are not fully persuasive, as for applicant's argument that the cited prior art does not teach "reproduction means for checking whether said authentication result information indicates that said content reproduction apparatus or said user

has been registered..., and, when said authentication result information indicates that said content data reproduction apparatus or said user has not been registered, checking said attribute information of said plurality of content data items", the examiner respectfully disagrees as Irwin, figure 3, item 168, teaches a identity repository which checks for authentication i.e. if user was previously registered, if user is not registered and data is not protected than anyone can access it. And Stefik, column 46, line 52 to column 47, line 21, teaches different rights can be set to digital media. One of the rights can be to only play the file and not be able to copy it hence not be able to store it in an external section; column 48, lines 36 through 54, rights to store/make copies are not granted till user decides to purchase the music; column 48, lines 36 through 54, rights to store/make copies are not granted till user decides to purchase the music. Therefore once file is requested to be played/stored externally it's rights/attributes will need to be checked to see if proper rights are there.

6. Stefik does not teach "transmission means", the examiner has said the Irwin does not teach the limitation a whole specifically focusing on the external storage part. Irwin does disclose a transmission means as shown elsewhere in the office action, for instance in claim 1, Irwin, figure 3, item 168, teaches a identity repository which checks for authentication i.e. if user was previously registered.

#### **Claim Rejections - 35 USC § 103**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-3, and 5-14 are rejected under 35 U.S.C. 103(a) as being anticipated by Irwin et al. (US PreGrant publication 7,289,273 B2) in view of Stefik (US Patent No: 5,715,403)

As per claim 1, Irwin discloses content data reproduction apparatus for reproducing content data, said content data reproduction apparatus comprising: transmission means for transmitting to a registration confirmation apparatus a confirmation request signal which requests said registration confirmation apparatus to confirm whether or not said content data reproduction apparatus or a user thereof has been registered; -Irwin, figure 3, item 168, teaches a identity repository which checks for authentication i.e. if user was previously registered

reception means for receiving authentication result information from said registration confirmation apparatus indicates whether said content data reproduction apparatus or said user thereof has been registered; -Irwin, columns 6, lines 1-32, col. 20, lines 23-60; teaches consumer device i.e. repository requests data from an intermediate rights provider registering itself and figure 3 checks if user registered.

storage means for storing content data acquired from a content data provision apparatus, said content data including a plurality of content data items each including attribute information indicating whether said content data items are prohibited from being stored external to said content data reproduction apparatus; -Irwin, columns 5, lines 40-67, teaches consumer device is an mp3 player which store data and column 5, line 60-61, teaches having a set of digital content, lines 45-46, teaches the digital content can be movies, audio files, pictures and more, line 64, teaches registering device, and lines 10-30 teaches creating a digital rights package associated

with the content and transmitting it to requesting registered device, i.e. the digital rights of the requesting device's plurality of content data items will be set.

setting means for setting said attribute information of said plurality of content data items, based on received sale notification signals; -Irwin, column 9, lines 42-45 teaches sale of rights and transferring rights from one entity to another and column 12 lines 45-54, teaches reviewing authorization and purchasing rights

and reproduction means for checking whether said authentication result information indicates that said content data reproduction apparatus or said user thereof has been registered in response to content data items when a reproduction command for one of said plurality of content data items input via an input means, -Irwin, column 9, lines 42-45, teaches sale of rights and transferring rights from one entity to another and column 12 lines 45-54, teaches reviewing authorization and purchasing rights, and figure 3, teaches if user is authenticated to give rights to content to play.

But does not disclose and when said authentication result information indicates that said content data reproduction apparatus or said user thereof has not been registered, checking said attribute information of said one of said plurality of content data items and reproducing said one of said plurality of content data items when said attribute information of said one of said plurality of content data items indicates that external storage of said one of said plurality of content data items is allowed

However, Stefik discloses and when said authentication result information indicates that said content data reproduction apparatus or said user thereof has not been registered, checking said attribute information of said one of said plurality of content data items and reproducing said

one of said plurality of content data items when said attribute information of said one of said plurality of content data items indicates that external storage of said one of said plurality of content data items is allowed. -Stefik, column 46, line 52 to column 47, line 21, teaches different rights can be set to digital media. One of the rights can be to only play the file and not be able to copy it hence not be able to store it in an external section; column 48, lines 36 through 54, rights to store/make copies are not granted till user decides to purchase the music; column 48, lines 36 through 54, rights to store/make copies are not granted till user decides to purchase the music.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the data reproduction device as described by Irwin and the digital rights management as taught by Stefik in order to implement a DRM for external storage. This would be applying a known technique to a known device (methods or products) ready for improvement

As per claim 2, Irwin in view of Stefik discloses the content data reproduction apparatus according to claim 1, further comprising: transmission means for transmitting a purchase notification signal to a content data sales apparatus which notifies said content data sales apparatus of an intention to purchase at least one of said plurality of content data items, -Irwin, column 9, lines 42-45 teaches sale of rights and transferring rights from one entity to another and column 12 lines 45-54, teaches reviewing authorization and purchasing rights, and figure 3, teaches if user is authenticated to give rights to content to play.

wherein when receiving from said content data sales apparatus a sale notification signal which notifies said content data reproduction apparatus that a sale of said at least one of said plurality of content data items is completed, said setting means sets said attribute information of

said at least one of said plurality of content data items to indicate informs that said at least one of said plurality of content data items is allowed to be stored external to said content data reproduction apparatus. -Stefik, column 46, line 52 to column 47, line 21, teaches different rights can be set to digital media. One of the rights can be to only play the file and not be able to copy it hence not be able to store it in an external section.

As per claim 3, Irwin in view of Stefik discloses the content data reproduction apparatus according to claim 2, wherein said attribute information of each of said plurality of content data items indicates whether a content data item of said plurality of content data items is allowed to be stored external to said content data reproduction apparatus while said content data item remains stored in said storage means or that said content data item is allowed to be stored external to said content data reproduction apparatus and that said content data item is to be deleted from said storage means. -Stefik, column 48, lines 36 through 54, teaches rights to store/make copies are not granted till user decides to purchase the music. User gets the right given the choices they make. If they are not paying they would be able to view it only if they pay they would get rights to copy. Once user pays the rights associated with the music are updated to allow user to make copies

As per claim 5, Irwin in view of Stefik discloses the content data reproduction apparatus according to claim 1, further comprising: readout means for reading out said content data from a storage medium, wherein said storage means stores said content data read by said readout means. -Stefik, column 48, lines 36 through 54, rights to store/make copies are not granted till user



decides to purchase the music. User gets the right given the choices they make. If they are not paying they would be able to view it only if they pay they would get rights to copy. Once user pays the rights associated with the music are updated to allow user to make copies. User being able to view the music file is reading it out. -Stefik, column 48, lines 36 through 54, teaches rights to store/make copies are not granted till user decides to purchase the music. User gets the right given the choices they make. If they are not paying they would be able to view it only if they pay they would get rights to copy. Once user pays the rights associated with the music are updated to allow user to make copies. User being able to view the music file is reading it out.

As per claim 6, Irwin in view of Stefik discloses the content data reproduction apparatus according to claim 1, wherein said content data provided from said content data provision includes attribute information indicating that said content data is prohibited from being external to said content data reproduction apparatus. -Stefik, column 46, line 52 to column 47, line 21, teaches different rights can be set to digital media. One of the rights can be to only play the file and not be able to copy it hence not be able to store it in an external section.

As per claim 7, Irwin in view of Stefik discloses the content data reproduction apparatus according to claim 6, further comprising: output means for outputting at least one of said plurality of content data items to a location external to said content data reproduction apparatus; and output control means for controlling said output means such that said at least one of said plurality of content data items is not output when said attribute information of said at least of one said plurality of content data items indicates that external storage is prohibited. -Stefik,

column 46, line 52 to column 47, line 21, teaches different rights can be set to digital media.

One of the rights can be to only play the file and not be able to copy it hence not be able to store it in an external section. Column 48, lines 36 through 54, rights to store/make copies are not granted till user decides to purchase the music. User gets the right given the choices they make. If they are not paying they would be able to view it only if they pay they would get rights to copy. Once user pays the rights associated with the music are updated to allow user to make copies. User being able to view the music file is reading it out. So Stefik discloses the a digital work can have permission rights associated with it which only allows user to view it and it can have rights to make copies and it can have multiple rights given what user chooses. Hence user can have one right till they make the purchase and their right changes i.e. receive additional rights to the digital media.

As per claim 8, Irwin discloses a registration confirmation apparatus, comprising:  
reception means for receiving from a content data reproduction apparatus a confirmation request signal which requests said registration confirmation apparatus to confirm whether or not said content data reproduction apparatus or a user thereof has been registered, said content data reproduction apparatus configured to store and reproduce content data including a plurality of content data items; -Irwin, columns 6, lines 1-32, col. 20, lines 23-60; teaches consumer device i.e. repository requests data from an intermediate rights provider registering itself and figure 3 checks if user registered.

first storage means for storing apparatus identification information identifying said content data reproduction apparatus or user identification information identifying said user

thereof, along with payment status information showing a payment status of said content data reproduction apparatus or said user; -Irwin, columns 5, lines 40-67, teaches consumer device is an mp3 player which store data and column 5, line 60-61, teaches having a set of digital content, lines 45-46, teaches the digital content can be movies, audio files, pictures and more, line 64, teaches registering device, and lines 10-30 teaches creating a digital rights package associated with the content and transmitting it to requesting registered device. i.e. the digital rights of the requesting device's plurality of content data items will be set.

determination means for checking said first storage means based on received apparatus identification information or received user identification information included in said received confirmation request signal to produce a determination result indicating whether or not said content data reproduction apparatus or said user thereof has been properly charged payment; - Irwin, column 9, lines 42-45 teaches sale of rights and transferring rights from one entity to another and column 12 lines 45-54, teaches reviewing authorization and purchasing rights

and transmission means for transmitting authentication result information to said content data reproduction indicating that said content data reproduction apparatus or said user thereof has been registered or that said content data reproduction apparatus or said user thereof has not been registered and that said plurality of content data items stored in said content data reproduction apparatus are not reproducible, based on the determination result. -Irwin, figure 3, item 168, teaches a identity repository which checks for authentication i.e. if user was previously registered

but does not disclose and that said plurality of content data items stored in said content data reproduction apparatus are reproducible,

However, Stefik discloses and that said plurality of content data items stored in said content data reproduction apparatus are reproducible, -Stefik, column 46, line 52 to column 47, line 21, teaches different rights can be set to digital media. One of the rights can be to only play the file and not be able to copy it hence not be able to store it in an external section; column 48, lines 36 through 54, rights to store/make copies are not granted till user decides to purchase the music; column 48, lines 36 through 54, rights to store/make copies are not granted till user decides to purchase the music.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the data reproduction device as described by Irwin and the digital rights management as taught by Stefik in order to implement a DRM for external storage. This would be

As per claim 9, Irwin in view of Stefik discloses the registration confirmation apparatus according to claim 8, further comprising: second storage means for storing content data; and content data transmission means for transmitting said content data stored in said second storage means to said content data reproduction apparatus response to a request from said content data reproduction apparatus. -Irwin figure 3, and Stefik, columns 27 and 28, teaches repositories communicate insuring other is registered and a message indicating registration is sent. There are two repositories which store and transmit the data between them.

As per claim 10, Irwin in view of Stefik discloses the registration confirmation apparatus according to claim 9, wherein said content data transmitted to said content data reproduction apparatus includes attribute information indicating that said content data is prohibited from being

stored external to said content data reproduction apparatus. -Stefik, column 46, line 52 to column 47, line 21, teaches different rights can be set to digital media. One of the rights can be to only play the file and not be able to copy it hence not be able to store it in an external section.

As per claims 11-14, Irwin discloses transmitting to a registration confirmation apparatus a confirmation request signal which requests said registration confirmation apparatus to confirm whether or not said content data reproduction apparatus or a user thereof has been registered; - Irwin, figure 3, item 168, teaches a identity repository which checks for authentication i.e. if user was previously registered

receiving authentication result information from said registration confirmation apparatus which indicates whether said content data reproduction apparatus or said user thereof has been registered; -Irwin, columns 6, lines 1-32, col. 20, lines 23-60; teaches consumer device i.e. repository requests data from an intermediate rights provider registering itself and figure 3 checks if user registered.

storing in a storage means content data acquired from a content data provision apparatus, said content data including a plurality of content data items each including attribute information; -Irwin, columns 5, lines 40-67, teaches consumer device is an mp3 player which store data and column 5, line 60-61, teaches having a set of digital content, lines 45-46, teaches the digital content can be movies, audio files, pictures and more, line 64, teaches registering device, and lines 10-30 teaches creating a digital rights package associated with the content and transmitting it to requesting registered device. i.e. the digital rights of the requesting device's plurality of content data items will be set.

setting said attribute information based on received sale notification signals; checking whether said authentication result information indicates that said content data reproduction apparatus or said user thereof has been registered in response to when a reproduction command for one of said plurality of content data items input via an input means; -Irwin, column 9, lines 42-45 teaches sale of rights and transferring rights from one entity to another and column 12 lines 45-54, teaches reviewing authorization and purchasing rights

and when said authentication result information indicates that said content data reproduction apparatus or said user thereof has not been registered. -Irwin, column 9, lines 42-45, teaches sale of rights and transferring rights from one entity to another and column 12 lines 45-54, teaches reviewing authorization and purchasing rights, and figure 3, teaches if user is authenticated to give rights to content to play and figure 3 checks to see if user is authenticated

but does not disclose attribute information indicating whether said content data items are prohibited from being stored external to said content data reproduction apparatus, checking said attribute information of said one of said plurality of content data items and reproducing said one of said plurality of content data items when said attribute information of said one of said plurality of content data items indicates that external storage of said one of said plurality of content data items is allowed

however, Stefik discloses attribute information indicating whether said content data items are prohibited from being stored external to said content data reproduction apparatus, checking said attribute information of said one of said plurality of content data items and reproducing said one of said plurality of content data items when said attribute information of said one of said plurality of content data items indicates that external storage of said one of said plurality of

content data items is allowed -Stefik, column 46, line 52 to column 47, line 21, teaches different rights can be set to digital media. One of the rights can be to only play the file and not be able to copy it hence not be able to store it in an external section; column 48, lines 36 through 54, rights to store/make copies are not granted till user decides to purchase the music; column 48, lines 36 through 54, rights to store/make copies are not granted till user decides to purchase the music.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the data reproduction device as described by Irwin and the digital rights management as taught by Stefik in order to implement a DRM for external storage. This would be applying a known technique to a known device (methods or products) ready for improvement

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being anticipated by Irwin in view of Stefik and further in view of Lin (US Patent No: 6,275,693 B1)

As per claim 4, Irwin in view of Stefik discloses the content data reproduction apparatus according to claim 1,

but fails to disclose wherein said transmission means transmits said confirmation request signal to said registration confirmation apparatus each time when said content data reproduction apparatus is powered on

However, Lin discloses wherein said transmission means transmits said confirmation request signal to said registration confirmation apparatus each time when said content data reproduction apparatus is powered on -Lin, column 4, lines 35-43, discloses powering on a device and registering it and that is a well known in the art to so, hence done automatically.

It would have been obvious at the time of the invention to modify the device registration as disclosed in Irwin with the mobile device registration as disclosed in Lin because it is desirable to connect to network automatically upon powering up of device as disclosed in Lin – Lin, column 4, lines 35-43, discloses powering on a device and registering it and that is a well known in the art to so, hence done automatically.

#### **Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Kanaan whose telephone number is (571)270-3906. The examiner can normally be reached on Mon-Thurs 7:30-5:00 EST.

If attempts to reach the above noted Examiner by telephone are unsuccessful, the Examiner's supervisor, Gilberto Barron, can be reached at the following telephone number: (571) 272-3799.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/SIMON KANAAN/  
Examiner, Art Unit 2432

/Benjamin E Lanier/  
Primary Examiner, Art Unit 2432